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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/675,278

09/30/2003

David E. Altobelli

1062/D41

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EXAMINER

PUNNOOSE, ROY M

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 09/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/675,278

Applicant(s)

ALTOBELLI ET AL.

Examiner

Roy M. Punnoose

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5,7-11 and 13-45 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19-25 and 33-40 is/are allowed.
- 6) ☒ Claim(s) 1,7-11,13,26-32,41,44 and 45 is/are rejected.
- 7) ☒ Claim(s) 2-5,14-18,42 and 43 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendments***

1. Acknowledgement is made of the Applicant's Amendments filed on July 03, 2006. The applicant has amended claims 1, 4, 7-11, 41 and 44, and cancelled claims 6 and 12. Currently, claims 1-5, 7-11 and 13-45 are pending in the application.
2. Applicant's amendment to correct 35 USC 112 rejections of the previous office action has been accepted.
3. Applicant's amendment has failed to overcome 35 USC 101 rejections of the previous office action.
4. After careful review and examination of the application, the Examiner has found new grounds for rejection, which is the subject of this office action.

### ***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
6. Claims 1, 7-11, 26-32, 41 and 44-45 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.
7. Claims 1 and 7 are rejected because it is claiming a non-tangible result. In claims 1 and 7, merely calculating a volume of the first aerosol would not appear to be sufficient to constitute a useful, concrete and tangible result, since the outcome of the calculating step has not been used in a disclosed practical application nor made available (in the claim) in such a manner that its usefulness in a disclosed practical application can be realized. See OG Notices: 22 November

2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

8. Further, claims 7, 26 and 44 are rejected because it is claiming a non-tangible object/device as a storage medium. In claims 7, 26 and 44, a storage medium containing instructions would not appear to be sufficient to constitute a useful, concrete and tangible object/device, since the storage medium according to the specification of the instant application "... includes but is not limited to, electronic, optical, ... or other storage ... devices" (see paragraph [0026]). Claims 7, 26 and 44 are rejected under 35 U.S.C. 101 because the claimed medium could literally be any type of medium imaginable, from a piece of paper to the side of a wall in a building to clouds in the sky, or a carrier wave, and therefore is an open-ended limitation without any specificity. See OG Notices: 22 November 2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

9. Further, claims 8-11, 27-32 and 45 are rejected for reasons similar to the reasons of rejection of claims 7, 26 and 44 above because they are not claiming a useful, concrete and tangible object/device as storage medium and therefore are directed to non-statutory subject matter and because claims 8-11, 27-32 and 45 comprise intermediate limitations of claims 7, 26 and 44 respectively.

10. Claim 41 is rejected because it is claiming a non-tangible result. In claim 41, merely determining a net amount of aerosol transferred would not appear to be sufficient to constitute a useful, concrete and tangible result, since the outcome of the determining step has not been used in a disclosed practical application nor made available (in the claim) in such a manner that its usefulness in a disclosed practical application can be realized. See OG Notices: 22 November

2005, "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility".

11. The applicant is requested to determine whether the claimed invention complies with the subject matter eligibility requirement of 35 U.S.C. Sec. 101, sentence 3, in the OG Notice from 22 November 2005, which states "In determining whether the claim is for a practical application, the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete, but rather that the final result achieved by the claimed invention is "useful, tangible, and concrete."

**Note:** Please note that claim 2, for example, have a method-step of "outputting a signal" as a final step, which is statutory subject matter and therefore would be allowable. In a similar manner, if claim 7 (and other similar claims) were amended to "a computer readable storage medium", then it would have statutory subject matter and therefore would be allowable.

### ***Double Patenting***

12. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

13. Claims 1, 7 and 13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 10 of copending Application No. **10/670,641**, and claim 4 of copending Application No. **10/670,924**. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1, 7 and 13 are claiming identical limitations as that claimed in the co-pending applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

#### ***Claim Objections***

14. Claims 2-5, 14-18 and 42-43 are objected to because they are dependent of rejected base claims.

15. Claim 13 is objected to because it is not clear how the “sensor operable to determine a pressure of an aerosol” is structurally related/connected to the rest of the claim, and its significance to the claimed invention. Appropriate correction is required.

#### ***Allowable Subject Matter***

16. Claims 19-25 and 33-40 would be allowable for reasons stated in the previous office action.

17. Claims 1-5, 7-11, 13-18, 26-32 and 41-45 would be allowable if the claims are amended to overcome the objections, the 35 USC 101 rejections and the Double Patenting rejections listed above, for reasons stated in the previous office action.

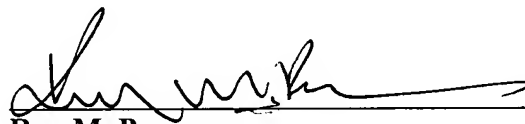
***Contact/Status Information***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**. The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

September 18, 2006

  
**Roy M. Punnoose**  
Patent Examiner  
Art Unit 2877